

Appl. No.: 10/090,888
Reply to Office Action of: 02/23/2005

REMARKS

Clarifying amendments have been made to the claims above. These amendments do not narrow or limit the scope of the claims and are not being made for purposed of patentability.

The examiner stated that claims 30-40 are directed to an invention that is independent or distinct from the invention originally claimed. The examiner has made an error. Claims 30-37 are dependent claims which are dependent upon claim 1. Dependent claims cannot be independent or distinct from their independent claim. As stated by applicants' attorney in the amendment filed 5/6/2004, claims 30-37 read on elected the Group I invention. Claims 30-37, because they are dependent upon claim 1, are drawn to the structures/structural elements of a system for adjusting an acoustic output. For example, claim 30 merely added additional details about the transmitter unit claimed in claim 1. As another example, claim 34 merely adds additional details about the sound generating system recited in claim 1. This point was raised in the last amendment, but the examiner failed to answer this traverse (see MPEP 707.07(f)). Piecemeal examination should be avoided (MPEP 707.07(g)) and the examiner's action should be complete as to all matters (MPEP 707.07 and 37 C.F.R. §1.104). The examiner is requested to reconsider his decision to withdraw claims 30-37 from consideration as being directed to a non-elected invention.

In regard to independent claim 38, it is not directed to an invention that is independent or distinct from the invention claim 1. Claim 38 is directed to a system for adjusting audio

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output having a transmitter unit and a sound generating system. Claim 1 is directed to a system for adjusting audio output having a transmitter unit and an entertainment sound generating system. If the examiner compares claim 38 to claim 1, the examiner will see that the invention claimed in claim 38 is not independent or distinct from the invention of claim 1. Therefore, the examiner is requested to examine claims 38-40.

If the examiner continues his restriction regarding claims 30-40, he is requested to make the restriction "final" so applicants' attorney can file a petition to have the restriction reviewed.

Claims 1-14 and 23-29 were rejected under 35 U.S.C. §103(a) as being unpatentable over Julstrom et al. (US 6,694,034). The examiner is requested to reconsider this rejection.

Applicants' attorney also hereby challenges the examiner's "well known in the art" Official Notice mentioned on the page 3, lines 3-5 of the office action mailed 02/23/2005. In accordance with MPEP §2144.03 the examiner is requested to cite a reference in support of his position.

Julstrom et al. discloses a primary audio source 105, a secondary audio source 107, and a switch system 103 (which may be located in a hearing aid) to select or switch between signals from the two sources (105, 107). The examiner is directed to column 3, line 39 - column 4, line 36. Another embodiment is shown in Fig. 2 which uses receiver 209 and microphone 207 as the two audio sources. Circuitry 212 in a hearing aid 203 selects either signals received from the

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microphone 207 or signals received by the receiver 209 (or a combined signal of the two). See column 4, lines 26-36.

Claim 1 claims that the sound generator comprises a player adapted to play the entertainment data. The examiner has stated that hearing aid 203 of Julstrom et al. is equivalent to applicants' claimed entertainment sound generating system, but admits that Julstrom et al. does not teach that the hearing aid 203 comprises a player adapted to play entertainment data. Applicants' attorney admits that audio players, such as CD players and MP3 players are known. However, nowhere is there a disclosure or suggestion of incorporating a CD player and MP3 player into the hearing aid 203 of Julstrom et al. This teaching only comes after reading the present patent application.

Claim 1 claims an entertainment sound generating system comprising a sound generator comprises a player adapted to play the entertainment data adapted to output entertainment sound signals and means for altering the entertainment sound signals from the sound generator based upon a signal transmitted by the signal transmitter to the receiver. There is no disclosure or suggestion of hearing aid 203 in Julstrom et al. comprising a player adapted to play the entertainment data, and the hearing aid 203 having means for altering the entertainment sound signals from the sound generator (i.e., the player) based upon a signal transmitted by the signal transmitter (telephone 205) to the receiver 209. The features of claim 1 are not disclosed or suggested in the art of record. Therefore, claim 1 is patentable and should be allowed.

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Though dependent claims 2-14 and 30-37 contain their own allowable subject matter, these claims should at least be allowable due to their dependence from allowable claim 1. However, to expedite prosecution at this time, no further comment will be made. Claims 30-33 and 35-37 have been amended to correct obvious errors in the claims. The claims have not been narrowed or limited by these amendments.

Regarding method claim 23, it claims receiving a hearing adjustment signal by the entertainment sound system from a portable transmitter, the hearing adjustment signal comprising information regarding a user's auditory characteristics. There is no disclosure or suggestion in Julstrom et al. that the telephone 205 sends a hearing adjustment signal comprising information regarding a user's auditory characteristics. There is no disclosure or suggestion in Julstrom et al. of the telephone 205 sending information regarding a user's auditory characteristics to the hearing aid 203. The features of Claim 23 are clearly not suggested in Julstrom et al.

Though dependent claims 24-29 contain their own allowable subject matter, these claims should at least be allowable due to their dependence from allowable claim 23. However, to expedite prosecution at this time, no further comment will be made.

Claim 38 claims that the transmitter unit is adapted to automatically send the signal to the receiver without user activation. There is no disclosure or suggestion of the features of claim 38 in the cited art. Therefore, claims 38-40 are patentable and should be allowed.

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For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issue remain, the examiner is invited to call applicants' attorney at the telephone number indicated below.

Respectfully submitted,

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4/12/05
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